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THIS DISPOSITION IS NOT  
CITABLE AS PRECEDENT  
OF THE TTAB

Paper No. 21  
RFC

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Martin Container, Inc.

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Serial No. 75/553,426

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Reconsideration Request

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Scott J. Major of Milan, White, Zelano & Branigan for  
Martin Container, Inc.

Scott Baldwin, Trademark Examining Attorney, Law Office 112  
(Janice O'Lear, Managing Attorney).

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Before Simms, Cissel and Hanak, Administrative Trademark  
Judges.

Opinion by Cissel, Administrative Trademark Judge:

On June 11, 2002, the Board affirmed the refusal to register on the Supplemental Register the mark in the above-identified application, "CONTAINER.COM." One month later, applicant filed a request for reconsideration of the Board's ruling, arguing that the Board erred in reaching its decision to affirm the refusal. Upon reconsideration, however, we cannot adopt applicant's conclusions with

regard to mistakes applicant asserts we made in resolving this appeal.

Applicant first argues that the wrong evidentiary standard was applied, reasserting the argument it presented at final hearing that this case is analogous to *In re Dial-a-Mattress Operating Corp.*, 57 USPQ2d 1807 (Fed. Cir. 2001). This argument is not any more persuasive now than it was then. We explained in our opinion why this case, which on first blush appears to be similar, is not analogous.

Next applicant argues that the Board misapplied the decision in *555-1212.com Inc. v. Communication House International Inc.*, 157 F.Supp.2d 1084, 59 USPQ2d 1453 (N.D.Cal. 2001). Our opinion cited this case in support of the proposition that "just as '555-1212.com' was held to be merely descriptive of providing databases featuring telephone and directory information accessible via electronic communications networks[, ] ... to the average consumer seeking to buy or rent containers, 'CONTAINER.COM' would immediately indicate a commercial web site on the Internet which provides containers." (opinion, pp. 4, 5.) This statement was followed by a reference to Professor McCarthy's treatise wherein he notes that a top level domain indicator does not possess source-identifying

significance and cannot function as a trademark, and further states that combining a TLD with otherwise unregistrable matter does not result in a combination that is somehow registrable.

We stand by this conclusion. While the court did not reach the conclusion that "555-1212.com" is generic for the services at issue in that case, its holding that this combination of a phone number with a TLD is merely descriptive supports the proposition for which we cited this case, namely that just as "555-1212.com" is merely descriptive of providing telephone information databases and information, "CONTAINER.COM" would immediately indicate to one seeking to buy or rent containers a commercial web site which provides containers.

Next applicant takes issue with the comment in our opinion that while applicant apparently does not currently sell its products on the Internet, this may not always be the case, and that, in any event, applicant uses the Internet for advertising. Applicant considers these statements to indicate that the Board reached its decision by considering not the services recited in the application, but rather what applicant "might do in the future."

As we indicated in our opinion, however, applicant had argued that the proposed mark is not generic because

applicant's services are not Web-based. The comments to which applicant refers in its request for reconsideration were made in response to this argument. Applicant's services need not be Web-based in order for the matter sought to be registered to be unregistrable. The key is that ".com" indicates a commercial web site, not whether applicant will conduct retail sales or only advertise by using its domain name in connection with its business activities on the Internet.

The final point argued in applicant's request for reconsideration is that the Board did not address applicant's contention that the Patent and Trademark Office has apparently changed its policy with regard to the registrability of marks combining generic terms with the TLD ".com." Applicant argues that "OFFICESUPPLIES.COM" is registered on the Supplemental Register for online retail services featuring office supplies, and that "BOOKS.COM" is registered on the Supplemental Register for online ordering services in the field of books, and contends that in view of this, "the sudden shift in the PTO's policy" should have been supported by either a judicial ruling or "consumer survey results demonstrating that [generic term].COM marks were incapable of functioning as indicators of origin." Applicant goes on to opine that without such support,

refusing registration in the instant case is "neither legally appropriate nor fair."

In this regard, it is well settled that the Board is not bound by prior decisions of Examining Attorneys to register other marks; rather, we are obligated to determine the registrability of only the marks in the applications before us, and we must do this based on the records in these applications, which presumably reflect the current state of our language as it is being used. Our opinion explained why we have concluded that "CONTAINER.COM" is not registrable on the Supplemental Register for retail services featuring metal shipping containers and rental of metal shipping containers. Whether or not this ruling appears to applicant to be consistent with previous determinations regarding the registrability of different marks made by different Examining Attorneys under different circumstances is not germane to this determination.

In summary, we have reconsidered our decision in this case in light of the arguments presented in applicant's request for reconsideration, but we cannot adopt applicant's conclusion that we erred. Accordingly, our decision affirming the refusal to register stands.